

REMARKS

This communication responds to the Office Action dated January 25, 2008. Claim 164 is amended, no claims are canceled, and no claims are added. Claims 149, 151-158, 160-164, and 170-174 have been amended to correct typographical errors, and not for reasons related to patentability. As a result, claims 149-183 are now pending in this Application.

§ 112 Rejection of the Claims

Claims 149-183 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. To support this rejection, the Office asserts that “the term ‘inheriting’ first appeared in the applicant’s claims on 5/17/2004. The applicant’s original disclosure provides no description of such a term. Therefore, all claims with the term ‘inheriting’ are rejected as failing to comply with the written description requirement.” The Applicant respectfully traverses.

First, it is respectfully noted that “... the specification and claims may not be rejected for lack of written description under Section 112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art.” See Patent Prosecution, Practice and Procedure Before The United States Patent Office, Ira H. Donner, 2002; citing *In re Skrivan*, 427 F.2d 801, (CCPA 1970). With this point in mind, it is respectfully asserted that the concept of inheritance between a parent and a child within hierarchical information structures is well-known to those of ordinary skill in the art. Examples of these relationships and inheritance include those for the Java language shown in “The Java Tutorials > Learning the Java Language > Interfaces and Inheritance” attached hereto as Exhibit A, and for a XML/databases in “Configuring Inheritance for a Parent (Root) Descriptor” attached hereto as Exhibit B.

The Application as originally-filed explicitly illustrates hierarchical parent and child relationships (including the use of the labels “parent” and “child”) as part of elements 204, 206, and 208 in FIG. 10. These relationships are described in the Application text as follows:

“A donut, more specifically, is an hierarchical attribute value pair data structure including a collection of crumbs. A crumb is the smallest unit of data corresponding to a meaning value pair associated with a particular donut. For example, a user's age would be a crumb associated with the user's primary donut. The donut data structure includes names plus associated crumbs. At the top level of the hierarchy, a top donut is associated with a user. a chat room, a network service, or other appropriate business entity or service. Each donut contains a set of crumbs and a set of sub-donuts. ... Some donuts are owned by only one parent donut. Other donuts are shared among several or many parent donuts. ... The term “donut” is used only as a label and refers to information residing on a server and accessible by a client for use in pushing or assigning particular content to the client. Structure 200 uses database tables for storing and maintaining the user-profile information, which includes any type of information identifying a user or corresponding client machine. Structure 200 includes a user table 202, identifying a particular network user, and each user would typically be identified by a separate table. ... A directory table 204 maintains a directory listing of the network users. A separate donut table 206 maintains user-profile information for a particular user. Donut table 206 is associated with the corresponding table 202 for that user and with the directory table 204. Donut table 206 is also associated with a donut hierarchy table 208, which identifies and maintains hierarchical relationships for table 206.” Application, pg. 21, line 21 – pg. 22, lines 25.

Thus, after reading the Application, one of ordinary skill in the art would easily understand the application of inheritance concepts with respect to the hierarchical relationships between parents and children, as depicted explicitly in FIG. 10 of the Application, and described in the Application text.

Second, the M.P.E.P. § 2164 *et seq.* notes that the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. Such a case requires:

1. a rational basis as to
 - a. why the disclosure does not teach, or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

“The Examiner must provide evidence ... supporting each of these elements for a rejection under the first paragraph of § 112 to be proper.” See *Patent Prosecution, Practice and Procedure Before The United States Patent Office*, Ira H. Donner, pg. 691, 2002.

Since the Application as-filed clearly establishes the hierarchical relationship between parents and children in a data structure to support the use of inheritance as claimed by the Applicant, and since evidence supporting each of the required elements noted above (e.g., that one of ordinary skill would be unable to practice embodiments of the invention without undue experimentation) has not been presented, a *prima facie* case to maintain a rejection of non-enablement under § 112, first paragraph, has not been properly established. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

§102 Rejection of the Claims

Claims 149-183 were rejected under 35 U.S.C. § 102(e) for anticipation by Rangan et al. (U.S. Patent No. 6,006,265; hereinafter “Rangan”). The Applicant does not admit that Rangan is prior art, and reserves the right to swear behind this reference in the future. In addition, since the Examiner has not established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection.

1) The Applicable Law

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

2) *Application of § 102 to The Rejected Claims – The Cited Reference Does Not Teach or Suggest the Presence of All Claim Elements:*

Independent claims 149, 158, 164, 170, and 175 recite the inheritance of “user profile attributes into the user profile from a group of which the user is a member” as well as the existence of a “hierarchical attribute value-pair data structure”. The Applicant was unable to find any evidence that these elements are taught or suggested within the bounds of Rangan.

The portions of Rangan cited by the Office teach the use of hyperlinks that can be interpreted based on previously-expressed preferences. *See* Rangan, Col. 9, lines 5-10. Examples include advertising spots chosen to reflect facts that may be known about the SUV (subscriber/user/viewer). *See* Rangan, Col. 11, lines 4-19. The selection of information that can be accessed may also be based on security information, or past user activity. *See* Rangan, Col. 28, lines 38-58.

However, none of the information given by Rangan shows inheritance of SUV profile information. Rather, SUV information in each case appears to be taken directly from current SUV activity, or past SUV activity. For example, membership in a “poor neighborhood” or a “rich neighborhood” and purchasing proclivities can easily be determined, and often are determined, simply by asking the SUV, or by directly observing the buying activities of the SUV. *See* Rangan, Col. 11, lines 4-17.

Similarly, none of the information provided by Rangan demonstrates using the “hierarchical attribute value-pair data structure” claimed by the Applicant. Indeed, the structure of the data used in the cited portions of Rangan is not specified.

In summary, the Applicant was unable to find any teaching or suggestion within the bounds of Rangan that makes use of inheritance or data structures as they are claimed by the Applicant in each of the independent claims. Dependent claims 150-157, 159-163, 165-169, 171-174, and 176-183 contain additional, patentable subject matter.

Therefore, since no *prima facie* case of anticipation has been established with respect to Rangan, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 149-183 under 35 U.S.C. § 102(e).

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at 210-308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23 day of April 2008.

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